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09/496,389	02/02/2000	Boris V. Marchegiani	33925-002	6138

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/496,389

**Applicant(s)**

MARCHEGIANI, BORIS V.

**Examiner**

Ella Colbert

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,15-17,19-26,28,29 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,15-17,19-26,28,29 and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 4-6, 8-11, 15-17, 19-26, 28, 29, and 35-40 are pending. Claims 1, 11, 17, 26, and 35 have been amended and claims 36-40 have been added in this communication filed 10/07/05 entered as Response After Non-Final Action.
2. The Change in Power of Attorney and Correspondence Address Change filed 12/01/05 has been entered.
3. The Amendment to the Specification filed 10/07/05 has been considered.
4. The 35 USC 112 second paragraph rejection for claims 1, 5, 9-11, 17, 20, 23, 24, 26, and 35 is hereby withdrawn in view of Applicant's amendments and arguments. However, the newly added claims 36 and 38 have a 35 USC 112 second paragraph issue as set forth here below.

### ***Drawing Objection***

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 1 has shading and figures 1-3B, 4A, 4B, 5A, and 5B do not have a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Newly added claims 36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 36 recites "... an arrangement to enable the tender initiator to reject the exception". The terms "an arrangement to enable" in claim 36 is a relative term which renders the claim indefinite. The terms "an arrangement to enable" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. "An arrangement to enable" renders "the initiator to reject" in the claim has been rendered indefinite by the user of the terms "an arrangement to enable" appearing in claim 36. Claim 38 has a similar problem.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 4, 11, 17, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO 99/05629) Bergato.

As per claims 1, 11, 17, 26, and 35, Bergato teaches, a system for utilizing at least one tender created by a tender initiator, comprising: a storage device storing data which relates to the at least one tender (Page 4, lines 7-28), and a processing device transmitting information corresponding to the data, wherein the at least one tender is provided for a complex multi-variable commodity, the processing device further enabling a tender recipient to request an exception to create or modify a term of the at least one tender (page (page 4, line 22-page line 9 and page 9, lines 7-27-"the sellers altering their offers" is a request to create or modify a term of at least one tender), a processing device transmitting information corresponding to the data, wherein the term of the at least one tender that is created or modified by the exception relates to a physical characteristic of the particular commodity (page 4, line 22 –page 6, line 14 – bidding (auction)). Bergato did not expressly disclose, a "tender". A "tender" by definition is to offer for payment of an obligation; an offer of money, services, etc. made to satisfy an obligation. Something offered in payment, especially money; to submit as a tender (to

tender a bid); a bid stating terms of a contract or a bid on a printed form submitted to buy securities at a certain price.

As per claim 11, Bergato teaches, A method for utilizing at least one tender created by a tender initiator, comprising the steps of receiving data for the at least one tender, the at least one tender being provided for a complex multi-variable commodity; and transmitting information corresponding to the data to a device (page 4, line 22-page 6, line 14 and page 19, lines 10-27).

As per claim 17, Bergato further teaches, A system for utilizing at least one tender that is created or modified by the exception relates to a physical characteristic of a particular commodity (page 4, line 7-page 7, line 18, page 8, line 11-page 9, line 27, and page 28, lines 6-28). The physical characteristic of a particular commodity such as a diamond can have the sales offer modified by the buyer wanting a different weight of diamond or a diamond with a different number of points or clarity.

As per independent claim 35 this independent claim reciting "A set of instructions residing in a storage medium, the set of instructions capable of being executed by a processor to implement a method for utilizing at least one tender" is rejected for the similar rationale as given for claims 11 and 26 because the method steps of claim 35 correspond to the steps of claims 11 and 26.

As per claim 4, Bergato teaches, the system according to claim 1, wherein the processing device executes a program on a remote device (page 4, lines 21-30).

11. Claims 5, 6, 8-10, 15, 16, 19-24, 28, 29, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergato in view of (US 6,421,653) May.

As per claims 5 and 20 The system according to claim 1, Bergato failed to teach, wherein the storage device includes a database storing data which is related to the at least one tender.

May discloses, wherein the storage device includes a database storing data which is related to the at least one tender (col. 13, lines 23-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the storage device include a database storing data which is related to the at least one tender and to modify in Bergato because such a modification would allow Bergato to have a storage device that includes a database for various data relating to diamonds to be offered for sale as well as other data concerning those diamonds.

As per claims 6 and 21 The system according to claim 5, Bergato failed to teach, wherein the database is a relational database. May teaches, wherein the database is a relational database. (col. 13, lines 32-34 and fig. 2 (66)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the database to be a relational database and to modify in Bergato because such a modification would allow Bergato to store information in tables- rows and columns of data- and to conduct searches using data in the specified columns of one table to find additional data in another table which is old and well known in the database art.

As per claims 8 and 22, the system according to claim 1, Bergato teaches, wherein the processing device: receives the data, analyzes the data, and transmits the information to a further processing device, wherein the information is transmitted in

response to the received data (page 16, line 13 – page 17, line 21 and page 22, lines 2-6).

As per claims 9, 15, 23, and 28, the system according to claim 1, Bergato teaches, wherein the processing device at least one of transmits and receives the information electronically via the Internet (page 15, lines 17-25).

As per claims 10,16, 24, and 29, the system according to claim 1, May failed to teach, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices.

May teaches, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices (col. 13, lines 35-65, col. 15, lines 2-22, and col. 23, line 56 –col. 24, line 53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device to be at least one of transmits and receives information electronically via a network of further processing devices and to modify in Bergato because such a modification would allow Bergato to have a processor that runs Microsoft web browser Internet Explorer and a dial-up networking and display setting for receiving and transmitting data.

As per claim 19, Bergato teaches, wherein the processing device executes a program on a remote device (page 4, lines 21-30).

As per claims 36-38, Bergato teaches, further comprising: an arrangement to enable the tender initiator to reject the exception (page 25, line 16-page 26, line 16).



As per claim 40, Bergato teaches, further comprising: instructions to perform the steps of claim 35 (page 4, lines 21-30).

***Response to Arguments***

12. Applicant's arguments filed 10/07/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: A buyer cannot enter a bid that seeks to alter in any way the information pertaining to the cut, clarity, color, etc of the stone on which he is bidding has been considered but is not persuasive. Response: the buyer can select another diamond to bid on pertaining to the cut, clarity, color, etc. of the stone on which he is bidding and the buyer does not have to take that stone because he can bid on another stone. This is considered an alteration (another alternative).

Issue no. 2: Applicant argues: No provision is made in the negotiations that occur through the Wiseman system for requesting modifications to terms pertaining to the physical characteristics of the underlying commodity has been considered but is not persuasive. The Wiseman reference was not used in the last non-final rejection. Bergato and May were used to reject the claims. Therefore, this argument is considered moot.

Issue no. 3: Applicant's argues: none of the references discussed in this response teaches or suggests enabling the tender initiator to reject the exception has been considered but is not persuasive. It is interpreted that Bergato does teach or suggest enabling the tender initiator to reject the exception on page 25, line 16-page 26, line 16.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicant's claimed limitations and one or more referenced passages in the Bergato and May references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

**>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is respectfully requested to particularly point out and to claim the novel feature of the invention in the independent claims. Where is this feature claimed in claims 1, 11, 17, 26, and 35?

**Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thiessen (US 5,495,412) disclosed interactive computer-assisted negotiations.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Inquiries**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Colbert', with a long horizontal line extending to the right.

E. Colbert  
Primary Examiner  
December 14, 2005